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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,726	01/26/2004	J. David Blaha	702.118	8631
37902	7590	03/21/2006	EXAMINER	
WRIGHT MEDICAL TECHNOLOGY, INC. 5677 AIRLINE ROAD ARLINGTON, TN 38002-9501			HOFFMAN, MARY C	
			ART UNIT	PAPER NUMBER
			3733	
DATE MAILED: 03/21/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/764,726

Applicant(s)

BLAHA ET AL.

Examiner

Mary Hoffman

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 5,11 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/26/2004.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

**DETAILED ACTION*****Election/Restrictions***

Applicant's election of Group I, Species A, and Subspecies I, claims 1-4 and 7-10, with traverse of the restriction/election requirement in the reply filed on 2/22/2006 is acknowledged. Please note that in Applicant's Traversal, claims readable on Subspecies I should be claims 1-7 and 9-10, not claims 107 and 9-10, due to a typo (see end portion of page 2). Regarding the restriction requirement, the traversal is on the ground(s) that the examiner has not met the burden of establishing why Inventions I and II are independent and distinct. Applicant states that because both the method and the apparatus are "for forming a cavity in the intramedullary canal", the reason given by the examiner, that the apparatus is capable of being used in a different location in the body, is insufficient and disregards the invention as claimed. The examiner respectfully disagrees, because a functional recitation of intended use in an apparatus claim does not limit the device to just that use, and using the device in another method than the claimed method does not disregard the invention as claimed. Other uses for a broach include removing dental pulp from the root canal, using in a sawing motion for cutting tissue, or cleaning out tissue in joint surgery, such as knee surgery. Furthermore, Inventions I and II have different fields of search, e.g. class 433/102 for Invention 1 and class 623/22 for Invention II.

Regarding the election requirement, the traversal is on the ground(s) that the examiner has not met the burden of establishing why Species A and Species B are

Art Unit: 3733

independent and distinct. This is not found persuasive because Species A and Species B are directed to related species. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j). In the instant case, the claims do not overlap in scope, for example, claim 4 is directed solely to Species A, while claim 5 is directed solely to Species B. They are not obvious variants, such as obvious shape, because applicant states in the specification a reason for using the specific shape of inwardly angled side walls (see page 8, line 1); and lastly, they are not capable of use together. However, after further consideration, the election requirement for Subspecies I and Subspecies II has been removed, because the difference between Subspecies I and Subspecies II is merely in the quantity of parts, which is not an unobvious difference, and therefore, Subspecies I and Subspecies II are obvious variants and are not subject to an election requirement.

Claims 5 and 11-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention/species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 2/22/2006.

***Claim Objections***

Claims 2-10 are objected to because of the following informalities: In claim 2, line 7, "the direction" should be changed to --a direction-- to be more clear for examination purposes. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said fins" in line 9. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deyerle (U.S. Patent No. 4,671,275) in view of Mackwood Ling et al. (U.S. Patent No. 6,241,772).

Deyerle discloses a apparatus (see Figs. 1-8) comprising an elongate body having a central longitudinal axis, a rearward end, a forward end, and a plurality of cutting teeth on a surface of the elongated body and being matched to corresponding corners of the prosthetic component, and a distal tip at the forward end of the elongate body. The cutting teeth (ref. #25) are along the corner edges, and side walls connect the cutting teeth of adjacent corner edges, the side walls extending inwardly from the cutting teeth in the direction of the central longitudinal axis. The body comprises four corner edges matched to corresponding corners of a prosthetic component of rectangular cross-section. The side walls have a concave configuration (ref. #22/23).

Deyerle discloses the claimed invention except for the bullet-shaped distal tip comprising a three fins or four fins, spaced at 90 degrees spaced locations about the central longitudinal axis, extending radial to the central longitudinal axis and extending longitudinally, distally from the forward end of the body to converge at an apex aligned with the central longitudinal axis, the fins being disposed inwardly.

Mackwood Ling et al. disclose a centralizing device for the stem of a prosthesis (see Fig. 4) including a bullet-shaped distal tip comprising a three fins and four fins, spaced at 90 degrees spaced locations about the central longitudinal axis, extending radial to the central longitudinal axis and extending longitudinally, distally from the forward end of the body to converge at an apex aligned with the central longitudinal axis, the fins being disposed inwardly in order to centralize the device at the distal end (col. 3, lines 22-35).

Art Unit: 3733

It would have been obvious to one of ordinary skill in the art to construct the device of Deyerle with a bullet-shaped distal tip comprising a three fins and four fins, spaced at 90 degrees spaced locations about the central longitudinal axis, extending radial to the central longitudinal axis and extending longitudinally, distally from the forward end of the body to converge at an apex aligned with the central longitudinal axis, the fins being disposed inwardly in view of Mackwood Ling et al. in order to centralize the device at the distal end.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached PTO-892.

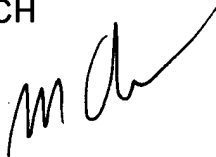
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3733

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MCH



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER